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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,244	02/19/1999	STEFAN BREUNIG	022701-803	2643

21839 7590 10/01/2002

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

29

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/202,244

Applicant(s)

BREUNIG ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 19 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 September 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached paper.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 22 to 25, 27 to 34, 36 to 42.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Margaret G. Moore
Margaret G. Moore
Primary Examiner
Art Unit: 1712

ATTACHMENT:

The amendment to the claims has not been entered, as it would raise a new issue, specifically new rejections, requiring further search and/or consideration.

In response to applicants' remarks, the Examiner notes that she does not find them persuasive of any novelty/unobviousness for the instant claims. Applicants argue that Jachmann et al. do not disclose or fairly suggest each feature of the claimed invention and note that the claimed process requires a heterogeneous catalytic composition. They state that "applicants believe that the reaction of Jachmann are conducted in the presence of a homogeneous catalyst". This position is not understood since column 8, line 63, specifically teaches a platinum on charcoal catalyst, which meets the claimed heterogeneous catalyst. This catalyst is one of only three catalysts specifically taught by Jachmann et al., and this is the basis for the 102/103 rationale.

With regards to applicants' alleged important and surprising advantages, the Examiner notes that no evidence has been provided establishing any criticality in the selection of the catalyst, and in fact the Examiner cannot find any specific mention in the specification that these advantages are associated with the catalyst selection.

With regards to claims 43 and 44, while not presently pending, the Examiner notes that, upon a cursory review, they would not appear to overcome the prior art. The Examiner does not remember ever asserting that the organopolysiloxane having epoxy groups and additionally SiH groups constitutes a synthon (as indicated on page 14 of their response).

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The fact that an alcohol reacts with a siloxane having SiH and Si bonded epoxy groups means that an epoxy reactant, i.e. applicants' synthon, has already been reacted with the SiH polymer. This is the same reaction mechanism claimed by applicants. The reaction step that applicants refer to as "stage one" on page 14 of their response is the reaction that corresponds to their claims. Applicants' drawing of this reaction only serves to prove the Examiner's point – that an epoxy compound, i.e. a synthon, is reacted with the same siloxane required by the claimed reaction. In fact, applicants' drawing of the reaction mechanism of "stage one" of Jachmann et al. differs from that claimed only in that the reaction mechanism includes a homogeneous catalyst, though Jachmann et al. also teach heterogeneous catalysts. The fact that this epoxy containing siloxane having SiH groups is further reacted with an alcohol does not distinguish the claims from the prior art.